

REMARKS

This application has been reviewed in light of the Office Action dated April 21, 2004. Claims 60 and 62 have been canceled, without prejudice or disclaimer of subject matter, and will not be further addressed herein. Claims 5-12, 14, 15, 17, 19, 25-30, 33, 58, 61 and 64 have been amended to define more clearly what Applicant regards as the invention, and Claims 21-24 and 31 have been amended to depend from Claim 6. Claims 68-71 have been added to provide Applicant with a more complete scope of protection. Claims 1-59, 61 and 63-71 are presented for examination. Claims 1, 3, 5, 33, 58, 61, 63, 66, 69, 70 and 71 are in independent form. Favorable reconsideration is requested.

Objections Under 37 C.F.R. § 1.75(c) and Rejections Under 35 U.S.C. § 112

Claims 10-12, 14, 15, 26 and 64¹ were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 10-12, 14 and 15 were objected to under 37 C.F.R. § 1.75(c), as supposedly being in improper dependent form for failing to limit their corresponding base claims.

The claims have been carefully reviewed and amended as deemed necessary to ensure that they conform fully to the requirements of 35 U.S.C. § 112, second paragraph, and 37 C.F.R. § 1.75(c), with special attention to the points raised in paragraph 4 of the Office Action. Specifically, Claim 5, the base claim for Claims 10-12 and 14, has been amended to recite accessing selected content requiring a fee based on at least one

¹ Although not listed in the statement of the rejection, Applicant assumes Claims 26 and 64 have also been rejected, as they are discussed in succeeding paragraphs 4(b) and 4(c) of the Office Action.

predefined user-preference pre-authorizing payment for content requiring a fee, and without further authorization prior to the accessing. One of ordinary skill in the art would readily understand that Claim 5 is generally directed to accessing information based on predefined user-preferences that pre-authorize payment, while Claims 10-12 and 14 are directed to establishing certain particular user-preferences. For example, the method of Claim 10 includes establishing predefined user-preferences to accept no more than a particular quantity of fees within a particular time period. Claim 10 further limits Claim 5, because it requires that the user-preferences used in Claim 5 include certain particular settings. Accordingly, it is respectfully submitted that Claims 10-12 and 14 are proper dependent claims, because it would not be possible to infringe any of these claims without also infringing Claim 5.²

The objection to Claim 15 under 37 C.F.R. § 1.75(c) and the rejection thereof under 35 U.S.C. § 112, second paragraph, are respectfully traversed. Claim 15 is directed to conditions relating to whether information is to be presented without prompting the user, whereas Claim 5 is directed to accessing content based on at least one predefined user-preference that pre-authorizes payment. One of ordinary skill in the art would readily understand that a method according to Claim 15 would include payment pre-authorization (as recited in Claim 5) and presentation of information without prompting the user (as recited in Claim 15). Thus, any method infringing Claim 15 would also infringe Claim 5, and Claim 15 therefore is a proper dependent claim.

² “The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.” M.P.E.P. § 608.01(n)(III).

Claim 26 has been amended to delete the language found objectionable by the Examiner, and Claim 64 has been amended to ensure proper antecedent basis for all its recited terms.

Claims 10-12, 14 and 15 have also been rejected under 35 U.S.C. § 112, second paragraph, as being incomplete. In particular, it is asserted that the claims must recite “utilizing the user defined settings of accepting a particular quantity of fees within a particular time period to authorize a transaction.” (Office Action at page 4). As explained above, Claims 10-12 and 14 recite particular predefined user preferences, whereas Claim 5 is generally directed to accessing information based on a predefined user-preference that pre-authorizes payment. As one skilled in the art would clearly appreciate in view of the present language of those claims (and because Claims 10-12 and 14 incorporate all of the features of Claim 5 therein), the accessing may be performed based on the respective user-preferences defined in those dependent claims. Therefore, it would not be necessary for Claims 10-12 and 14 to include another step relating to additional utilization of the user-preferences.

Moreover, the rejection of Claim 15 on these grounds is respectfully traversed. Claim 15 is not directed to merely user-defined settings for authorizing a transaction. Rather, as discussed above, that claim is directed to presenting content without prompting the user. As such, the stated grounds of rejection (i.e., that the claim must recite “utilizing the user defined settings of accepting a particular quantity of fees within a particular time period to authorize a transaction”) are believed to be irrelevant to Claim 15 and invalid.

For at least the above reasons, it is believed that the objection under 37 C.F.R. § 1.75(c) and the rejections under 35 U.S.C. § 112, second paragraph, have been obviated, and their withdrawal is therefore respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1-9, 11, 13, 14, 16-23, 25, 27-37, 39, 40, 42-53, 55-57 and 63-67 were rejected under 35 U.S.C. § 103(a) as being obvious from U.S. Patent No. 6,151,600 (“Dedrick”). Claims 10, 12, 15, 24, 26, 38, 41 and 54 were rejected as obvious over Dedrick in view of U.S. Patent No. 5,953,710 (“Fleming”), and Claims 58, 59 and 61 were rejected as obvious over Dedrick in view of U.S. Patent No. 6,282,653 (“Berstis”).

Claim 1

Claim 1 is directed to a method of enabling a user to obtain fee-based content over a network. The method includes setting user-defined parameters to accept all fees below a predetermined amount. A first portion of content, from a content provider location, is displayed at a user location and a determination is made as to whether a second portion of content requires payment of a fee by the user. The second portion of the content is displayed to the user when the fee for the second portion of content is accepted based on the user-defined parameters. A plurality of fees incurred by the user is accumulated at a third party provider location. The third party provider pays the content provider the amount of the fees incurred by the user and the user makes payment to the third party provider on a periodic basis.

Among the advantages provided by these claimed features, is that they provide a system in which a user can seamlessly access fee-based content. Specifically, the method includes setting user-defined parameters to accept all fees below a predetermined amount, which allows the user to browse and purchase fee-based content without requiring further action to approve each individual purchase.

By contrast, while Dedrick discusses accessing fee-based content, the associated fees are simply deducted from a user account balance until that account is depleted:

[T]he metering process 36 calculates the price of the requested information and accesses the transaction database to subtract the price from the balance of the end user's account....If the balance minus price is greater than zero, the metering process 36 retrieves the information and sends the same to the end user. If the balance minus price is less than zero, the metering process 36 does not retrieve the information and may send a message to the end user that the balance has been exceeded.

(Dedrick at col. 11, lns. 21-36). Under this arrangement, the user does not have the opportunity to set a threshold for individual purchases of information. Thus, for example, a user might not be aware that he is selecting expensive content until he is notified that his account is depleted.

Dedrick also describes the use of an “appraisal agent” to locate advertisements for an item that a user wishes to purchase, according to criteria provided by the user:

[T]he appraisal agent 28 may be programmed by the end user to locate a particular item. For example, the end user may program the appraisal agent 28 to locate, and possibly purchase, a camera. The end user would define the search criteria for the appraisal agent 28 to find an advertisement(s) for a camera which meets the end user's needs, such as a

particular brand, features, price, etc. Once located, the advertisement is returned to the end user. Alternatively, the appraisal agent 28 may be programmed to purchase an advertised camera once an advertisement is found which matches the search criteria.

(Dedrick at col. 8, lns. 19-29). However, these criteria apply to the purchase an item of merchandise, rather than the retrieval of fee-based content. Moreover, the criteria are applied to the retrieval of one specific item, e.g., a camera, and the use of that criteria ends once the item has been purchased. By contrast, Claim 1 recites setting user-defined parameters to accept all fees below a predetermined amount. Thus, the user may select numerous items of fee-based content as long as the fee for each selected item is below the predetermined amount.

Applicant therefore respectfully submits that nothing has been found or pointed out in Dedrick that would teach or suggest a method of enabling a user to obtain fee-based content over a network that includes setting user-defined parameters to accept all fees below a predetermined amount, as recited in Claim 1. Accordingly, Claim 1 is believed to be patentable over Dedrick.

Claim 3

Claim 3 recites a system that receives user-defined parameters relating to acceptance of fees and determines whether additional content is desired such that if a fee for the additional content does not exceed a predetermined amount, the additional content is retrieved, and wherein fees incurred by a user are accumulated by a payment appliance.

Dedrick, as discussed above, provides an appraisal agent for locating advertisements or electronic information fitting certain criteria and possibly purchasing a

particular desired item corresponding to an advertisement. The features recited in Claim 3, on the other hand, generally speaking, relate to the retrieval of content, rather than the purchase of an item of merchandise. Moreover, Dedrick is concerned with searching for and purchasing one particular item of merchandise, whereas the system of Claim 3 is intended to allow a user to transparently select numerous items of fee-based content from various sources without regard to the cost of each individual item of content, and the fees for the selected content are accumulated. Thus, in Applicant's view, nothing in Dedrick teaches or suggests receiving user-defined parameters relating to acceptance of fees and determining whether additional content is desired, such that if a fee for the additional content does not exceed a predetermined amount, the additional content is retrieved, and wherein incurred fees are accumulated, as recited in Claim 3.

Claim 5

Claim 5 is directed to a method accessing content over a network. The method includes accessing, through the network, selected content that requires a fee to be accessed, based on at least one predefined user-preference pre-authorizing payment for content requiring a fee, and without further authorization prior to the accessing. The method further recites accumulating fees to account for all those incurred for accessing each selected content accessed in the accessing.

Generally speaking, these features allow a user to access selected content over a network without regard to whether a fee is required, because the user has already defined preference that pre-authorizes such fees to be paid. Implicit in this arrangement is

that the user can transparently select content for which a fee is required, without providing further authorization.

Nothing has been found in Dedrick that would teach or suggest accessing selected content requiring a fee, based on at least one user-defined setting pre-authorizing payment, and without further authorization prior to the accessing, as recited in Claim 5. Indeed, Dedrick is understood to merely deducts fees for fee-based content from a user account balance until that account is depleted, rather than accumulating fees (e.g., at a third party provider) and paying the content provider the amount of the accumulated fees.

Claims 69 and 70

New independent Claims 69 and 70 are computer memory medium claims corresponding in many relevant respects to method Claims 1 and 5, respectively, and are believed to be patentable over Dedrick for at least the same reasons as discussed above in connection with Claims 1 and 5, respectively.

Claim 33

Claim 33 is directed to a system that enables a user to access fee-based content from a remote location. A client information appliance receives user-defined settings regarding acceptance of fees and retrieves content from a remote location. A content provider appliance, sponsored by a content provider, provides content to one or more client information appliances. The client information appliance determines whether the retrieved content requires payment of a fee and if so, determines whether the content has been pre-approved by user-defined settings. If the content has been pre-approved, it is

accepted without further authorization by a user. A payment appliance accumulates fees incurred by a user and to remits payment to the content provider based on the accumulated fees.

Among other advantages, these features provide the user with a way of accessing fee-based content without having to approve or enter payment information for each individual purchase, because the user-defined settings control the incurring of fees without additional user action.

Dedrick, in Applicant's view, does not teach or suggest the use of user-defined settings regarding acceptance of fees and determining whether the content has been pre-approved by user-defined settings, as recited in Claim 33. Rather, as discussed above, Dedrick's system simply deducts the cost of the retrieved content from a user's account until the account is depleted.

Accordingly, Claim 33 is believed to be patentable over Dedrick.

Claims 58 and 61

Claim 58 is directed to a method of providing payment of royalties for fee-based content over a network. User-defined parameters are set that pre-authorize retrieval of content data requiring a fee to be retrieved, so that no further authorization is required. Desired content data is selected from a provider and a first portion of the selected content data, which is provided without a fee, is retrieved at a user location. A determination is made as to whether a second portion of the selected content data, which has an associated fee, is desired. When the second portion of the selected content data is accepted based on the user-defined parameters, the associated fee is calculated, a portion of which includes a

royalty. The royalty portion of the fee is paid on a periodic basis, and a content portion of the fee is paid to the content provider on a periodic basis.

Dedrick, as acknowledged in the Office Action, does not teach or suggest the payment of royalties. Nor, for the reasons discussed above, is Dedrick believed to teach or suggest setting user-defined parameters that authorize retrieval of content data without prompting the user for acceptance of an associated fee, as recited in amended Claim 58.

Berstis discusses a system that manages royalty collection by establishing a user payment account, a content-provider royalty account and a count file that limits the number of times the content may be accessed (see, e.g., Fig. 5). However, Berstis suffers from the same shortcomings as Dedrick in that it requires a user to specifically authorize payment for each separate purchase of fee-based content (i.e., each time a purchase is made). Nothing has been found in Berstis that would teach or suggest setting user-defined parameters that pre-authorize retrieval of content data requiring a fee to be retrieved, so that no further authorization is required. Thus, even if Berstis were combined with Dedrick, assuming *arguendo* such a combination were proper, the resulting combination still would not teach or suggest the emphasized features of Claim 58.

Accordingly, Claim 58 is believed to be patentable over Dedrick and Berstis, whether considered separately or in combination. Claim 61 recites features similar to those discussed above with respect to Claim 58 and therefore is also believed to be patentable over Dedrick and Berstis, whether considered separately or in combination, for the reasons discussed above in connection with Claim 58.

Claims 63 and 66

Claim 63 is directed to a method for enabling a user to access content data and purchase items and/or services over a network. A first amount is pre-authorized for payment of content data by inputting user-defined parameters, and a second amount is pre-authorized for payment of items and/or services by the user-defined parameters. Content is retrieved from a content provider, to a user location, via the network. A determination is made as to whether payment for the content has been pre-authorized by the user-defined parameters, and if the content has been pre-authorized, the user incurs a fee for the content. The content data is displayed to the user, the content data including one or more items and/or services. Content-related fees incurred by the user are accumulated at a third party provider.

Claim 63 further recites that an item and/or service is selected that has an associated fee. A determination is made as to whether payment for the item and/or service has been pre-authorized by the user-defined parameters, wherein if payment for the item and/or service has been pre-authorized, the user incurs an associated fee. The third party provider pays the content provider the amount of the accumulated fees, and the user makes payment to the third party provider.

Again, as discussed above, Dedrick is not believed to teach or suggest the use of user-defined parameters to pre-authorize the purchase of fee-based content. Moreover, nothing has been found in Dedrick that would teach or suggest the specific arrangement of Claim 63, in which a first amount is pre-authorized for payment of content data by inputting user-defined parameters, and a second amount is pre-authorized for payment of items and/or services by the user-defined parameters.

Accordingly Claim 63 is believed to be patentable over Dedrick. Claim 66 recites features similar to those discussed above with respect to Claim 63 and therefore is also believed to be patentable over Dedrick for the reasons discussed above.

Claim 71 recites a method for interacting with a network, including electronically pre-authorizing payment for any electronic content that requires payment of a fee to be accessed over the network. The method further includes accessing, through the network, selected electronic content that requires payment of a fee to be accessed, from selected ones of any available plural content providers, based on the electronic pre-authorizing.

It is respectfully submitted that neither Dedrick nor Berstis, taken individually or in any permissible combination, is seen to teach or suggest the foregoing features of Claim 71. Accordingly, Claim 71 is believed to be clearly patentable over those references.

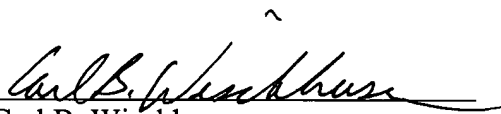
A review of the other art of record, including Fleming, has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. All of the independent claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


Carl B. Wischhusen
Attorney for Applicant
Registration No. 43,279

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_Main 439542_2